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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,732	01/08/2004	Pieter de Haan	O 1997.273 US C3	1198
27624	7590	02/10/2006	EXAMINER	
AKZO NOBEL INC. INTELLECTUAL PROPERTY DEPARTMENT 7 LIVINGSTONE AVENUE DOBBS FERRY, NY 10522-3408			ROYDS, LESLIE A	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/754,732	Applicant(s) HAAN ET AL.	
	Examiner Leslie A. Royds	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/403,139.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 13-19 are presented for examination.

Applicant's Amendment filed October 3, 2005 was received and entered into the application, but was found to be non-compliant. Notice to that effect was sent November 4, 2005. Applicant's Amendment filed November 14, 2005 in response to the Notice was received and entered into the application. Applicant's subsequent submission of the Amendment filed November 28, 2005 was also received and entered into the application and supercedes the Amendment filed November 14, 2005. Accordingly, the specification at pages 1-2 has been amended.

In light of the amendments and accompanying remarks, the objection to the specification for improper incorporation by reference and the objections to the specification for minor informalities as set forth at pages 2-3 of the previous Office Action dated April 1, 2005 have each been hereby **withdrawn**.

In light of the acceptable nature of the Terminal Disclaimers filed October 4, 2005 over U.S. Patent Application No. 10/754,733 and U.S. Patent Nos. 6,514,958 and 6,399,594, each of which has been received and entered into the present application, the provisional obviousness-type double patenting rejection over U.S. Patent Application No. 10/754,733 and the non-provisional obviousness-type double patenting rejections over U.S. Patent Nos. 6,514,958 or 6,399,594 have each been hereby **withdrawn**.

Objection to the Specification

Applicant has noted that the specification will be amended in reference to the trademark LIVIAL prior to issuance of this application. Insofar as the specification has not been amended to properly set forth the trademarked name, the objection remains proper and is repeated below.

The use of the trademark LIVIAL has been noted in this application at page 1, line 10 of the disclosure. Each letter should be capitalized and be accompanied by the generic terminology wherever the name appears. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Claim Rejection - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 13-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kelder et al. (U.S. Patent No. 4,701,450; 1987) in view of Deckers et al. (EP 0613687; 1994), Handbook of Pharmaceutical Excipients (1986, p. 108-110, 259-260, 289-293), Loliger et al. (U.S. Patent No. 5,364,886; 1994) and Sas et al. (EP 0389035; 1990), each already of record, for the reasons of record as set forth at pages 4-10 of the previous Office Action dated April 1, 2005.

Applicant's remarks have each been carefully considered, but fail to be persuasive in establishing error in the propriety of the present rejection.

Applicant states that the Examiner has used impermissible hindsight in an attempt to reconstruct the invention from the prior art. Applicant submits that there is nothing in the teachings of the cited prior art that address the question of improved stability and/or storage, nor do any of the cited documents, either alone or in combination, teach or suggest the capsule of the present application with a carrier having at least 47% to 90% by weight of lactose and 0.1 to 10% by weight tibolone or an indication of the resulting stability. Applicant states that Deckers et al., Handbook of Pharmaceutical Excipients and Loliger et al. do not remedy the deficiencies of Kelder et al. Applicant states that one looking to the question of stability and/or storage would not be led to the cited prior art to solve the problems with regard to stability and/or storage.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

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long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Insofar as the present conclusion of obviousness has been made solely on the knowledge that was generally available to one of ordinary skill in the art at the time of the invention, and not, in any way, from the guidance or direction proposed by Applicant in the present specification, the rejection is proper and has not been constructed via impermissible hindsight.

In response to Applicant's argument that there is nothing in the teachings of the cited prior art that addresses the question of improved stability and/or storage, Applicant's attention is directed to pages 9-10 of the previous Office Action dated April 1, 2005. Crystalline tibolone formulated in combination with starch, ascorbyl palmitate, magnesium stearate and lactose was known to be chemically appreciably more stable than compositions comprising polymorphous tibolone (see Sas, page 1, lines 42-44 and Example 6, page 3, lines 35-52). Such a teaching raises the reasonable expectation of success that the tibolone composition disclosed by Kelder et al., which is also in combination with starch and does not preclude the use of a crystalline form of tibolone, would also have been chemically appreciably more stable, i.e., have increased stability.

In addition, the Handbook reference explicitly acknowledges that uncooked dry starch is quite stable during storage if protected from high humidity and also teaches that starch is commonly used as a diluent or binder in the preparation of potent drugs, particularly dry-filled capsules and tablets (see page 293). Such teachings are reasonably suggestive that the use of

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starch in a pharmaceutical preparation would have necessarily imparted stability to the composition since the starch itself was known to be highly stable when protected from high humidity. Furthermore, the reasonable suggestion of increased stability of a pharmaceutical preparation would have also indicated to one of ordinary skill in the art that prolonged storage time may be achieved with a more stable composition because the product could be maintained for longer without significant degradation and, thus, could be stored for an extended period of time.

Furthermore, in response to Applicant's remark that none of the cited references, either alone or in combination, teach or suggest a capsule with a carrier having at least 47% to 90% by weight of lactose and 0.1% to 10% by weight tibolone, Applicant's attention is directed to pages 4-10 of the previous Office Action dated April 1, 2005. Applicant has presently argued against and discussed the references individually without clearly addressing the combined teachings. It must be remembered that the references are relied upon in combination and are not meant to be considered separately as in a vacuum. Rather, it is the combination of all of the cited and relied upon references that make up the state of the art with regard to the claimed invention. Applicant's claimed invention fails to patentably distinguish over the state of the art represented by the cited references and the scientific reasoning that would have been generally used by one of ordinary skill in the art. See *In re Young*, 403 F.2d 754, 159 USPQ 725 (CCPA 1968) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In the instant case, it is again noted that while the embodiment of Example 1 (see Kelder et al., col.4, lines 49-68) that was relied upon for the present rejection does not explicitly teach the exact range of components as presently claimed, Kelder et al. teaches a particular

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embodiment of the disclosed composition in which the active compound, in this case, tibolone (see col.4, lines 49-50 and also col.2, lines 47-49), comprises 2.5 mg of the dose unit in combination with potato starch (10.0 mg), magnesium stearate (0.5 mg), ascorbyl palmitate (0.2 mg), amylopectin (2.0 mg) and lactose, in an amount to make up to 100 mg of the tablet. Thus, for a 100 mg tablet as disclosed in line 54 of Kelder et al., tibolone is 2.5%, potato starch is 10%, magnesium stearate is 0.5%, ascorbyl palmitate is 0.2%, amylopectin is 2.0% and lactose is 84.8% of the final tablet product. Thus, such a formulation is sufficient disclosure or suggestion to one of ordinary skill in the art to meet Applicant's limitation of 0.1 to 10% by weight of tibolone, at least 10% up to 50% of starch in the carrier (see present claim 14), or up to 5% stabilizer as recited in present claim 16. While such an example was expressly directed to a tablet formulation, Kelder et al. broadly teaches the use of "(micro)-capsules" (col.2, line 63), which would have reasonably suggested to one of ordinary skill in the art that the exemplified proportioning of ingredients would also apply to dosage forms other than tablets, including capsules.

In further support thereof, Applicant is again directed to the MPEP at §2123, which states, "A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments...Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments."

In response to Applicant's argument that Deckers et al., Handbook of Pharmaceutical Excipients or Loliger et al. do not teach the use of a capsule with a carrier having at least 47% to 90% by weight of lactose and 0.1 to 10% by weight tibolone or an indication of the resulting

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stability, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In the instant case, the Office Action did not assert that the Deckers et al. reference, the Handbook reference and the Loliger et al. reference taught, in its entirety, the presently claimed invention. Rather, the references were relied upon to show the knowledge generally available to one of ordinary skill in the art at the time of the invention. Thus, the fact that Deckers et al., Handbook of Pharmaceutical Excipients or Loliger et al. do not teach the entire invention is immaterial because the references were not relied upon to comprehensively teach all of the limitations now presently claimed.

Applicant is also reminded that express motivation to combine must not be explicitly stated in the prior art. Please reference MPEP §2145(X), which states, "However, there is no requirement that an "express, written motivation to combine must appear in the prior art references before a finding of obviousness."

Although Applicant argues that one of skill in the art would not be led to the cited prior art to solve problems with regard to stability and/or storage of tibolone compositions, such an assertion is, respectfully, not persuasive. The skilled artisan would necessarily have considered the prior art generally available at the time of the invention regarding known formulations of tibolone and components commonly used as stabilizers, preservatives and carriers of pharmaceutical preparations. Such a person would not have limited their scope of knowledge

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only to what was known in the prior art regarding stability and storage characteristics. Thus, the cited prior art is properly considered relevant.

This conclusion is supported by the MPEP at §2141.01(a)[R-2], which states, “The Examiner must determine what is ‘analogous prior art’ for the purpose of analyzing the obviousness of the subject matter at issue. ‘In order to rely on a reference as a basis for rejection of an Applicant’s invention, the reference must either be in the field of Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.’ ... *‘A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.’*” (emphasis added)

For these reasons and those already made of record at pages 4-10 of the previous Office Action dated April 1, 2005, claims 13-19 remain properly rejected.

Double Patenting

Obviousness-Type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Provisional Rejection

Claims 13-19 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-23 of copending U.S. Patent Application No. 10/754,685, in view of Deckers et al. (EP 0613687; 1994) and Kelder et al. (U.S. Patent No. 4,701,450; 1987), each already of record, for the reasons already made of record at pages 10-14 of the previous Office Action dated April 1, 2005.

Applicant's Terminal Disclaimers have been carefully reviewed and considered. Insofar as Applicant has submitted a Terminal Disclaimer over U.S. Patent Application No. 10/745,685, the Terminal Disclaimer is not accepted and the claims remain provisionally rejected. Applicant may wish to consider revising the Terminal Disclaimer to properly reflect the application number of the copending application over which the present rejection was made (i.e., 10/754,685).

Conclusion

Rejection of claims 13-19 remains proper and is **maintained**.

No claims of the present application are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

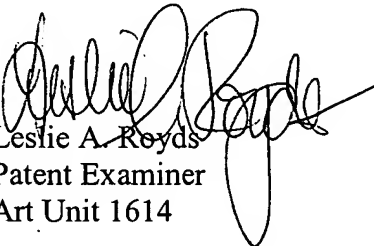
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The examiner can normally be reached on Monday-Friday (8:30 AM-5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

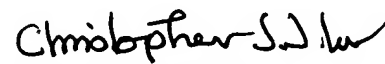
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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

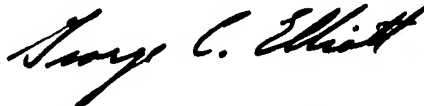


Leslie A. Royds
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January 23, 2006



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